

08/188, 668



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08/188, 668 01/26/94 CHEN

S E2750

EXAMINER

E3M1 / 0406

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2306

DATE MAILED:

04/06/95

This is a communication from the examiner in charge of your application.
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ART UNIT PAPER NUMBER

This application has been examined Responsive to communication filed on 12-23-94 This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), 0 days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. Notice of References Cited by Examiner, PTO-892.
2. Notice of Draftsman's Patent Drawing Review, PTO-948.
3. Notice of Art Cited by Applicant, PTO-1449.
4. Notice of Informal Patent Application, PTO-152.
5. Information on How to Effect Drawing Changes, PTO-1474..
6.

Part II SUMMARY OF ACTION

1. Claims 1-4 are pending in the application.
2. Claims _____ are withdrawn from consideration.
3. Claims _____ are allowed.
4. Claims 1-4 are rejected.
5. Claims _____ are objected to.
6. Claims _____ are subject to restriction or election requirement.
7. This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. Formal drawings are required in response to this Office action.
9. The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are acceptable; not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).
10. The proposed additional or substitute sheet(s) of drawings, filed on 12-23-94, has (have) been approved by the examiner; disapproved by the examiner (see explanation) but *not yet reviewed by the Draftsman*.
11. The proposed drawing correction, filed _____, has been approved; disapproved (see explanation).
12. Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has been received not been received been filed in parent application, serial no. _____; filed on _____.
13. Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. Other

EXAMINER'S ACTION

Art Unit: 2306

1. This Office action is responsive to applicant's correspondence filed on December 23, 1994. Claims 1-4 are pending.

2. 35 U.S.C. § 101 reads as follows:

"Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title".

3. Claims 1-4 are rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter.

Please see paragraph no. 4 of the first Office action.

4. Applicant's arguments regarding the rejection of claims 1 and 2 under 35 U.S.C. § 101 have been fully considered but they are not deemed to be persuasive.

Applicant basically argues that the step of "storing in said memory" renders the claim statutory.

In response to this argument, the examiner contends that claims 1 and 2 and added claims 3 and 4 stand rejected under 35 U.S.C. § 101 due to the following:

As per claims 1-4, the newly added step of "storing in said memory ..." represents insignificant post-solution activity. The stored data representative of a signed magnitude quotient in the claimed storing step is a mere number that is not used to refine or limit other process steps. As stated in Abele:

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If, however, the mathematical algorithm is merely presented and solved by the claimed invention, as was the case in Benson and Flook, and is not applied in any manner to physical elements or process steps, no amount of post-solution activity will render the claim statutory; nor is it saved by a preamble merely reciting the field of use of the mathematical algorithm.

The courts have held that any non-essential "post-solution" activity fails to render the claims statutory. See Parker v. Flook 198 USPQ 193, 197 (S Ct 1978). Many different types of insignificant post-solution activity have been dealt with by the courts : the transmission of data In re Castelet 195 USPQ 439, 446 (CCPA 1977), the display of the analog equivalent of a number (a shade of gray) In re Abele 214 USPQ at 688, and the updating of an alarm limit Parker v. Flook. Based upon the foregoing, we conclude that the "storing" step in the method claims 1-4 is nothing more than insignificant post-solution activity.

Therefore, as mentioned in paragraph no. 4 of the previous Office action, it is readily apparent that when claims 1-4 are each taken as a whole, the claims are directed to the preemption of a mathematical algorithm, and thus are non-statutory.

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION

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IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Emmanuel Moise whose telephone number is (703) 305-9763.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3800.

EM
Emmanuel Moise

April 2, 1995



ROY N. ENVALL, JR.
Supervisory
Patent Examiner
Group 2300